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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,250	12/12/2001	John Ruckart	36968/262329 (BS 001253)	6309
23552	7590	09/26/2006	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			KRAMER, JAMES A	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/015,250

Applicant(s)

RUCKART, JOHN

Examiner

James A. Kramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,7,8,10,11,18,19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 7-8, 10-11, 18-19, 21-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 25-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner notes that Applicant has amended the claims to recite the following functionality, “positioning the non-billing information at a location relative to the location of the billing information in the customized communication that varies from the location relative to the billing information in at least one prior customized communication to the customer, so that the billing information is not always in the same area of the customized communication.”

The only support for this step in Applicant’s Specification resides in the Summary of the Invention section. Specifically, page 2, paragraph 0007 includes the following language, “the billing information is not always located in the same area of the newsletter.” As this is the only support for the newly added limitation, Examiner asserts that one of ordinary skill at the time of the invention would not have reasonably concluded from Applicant’s Specification that Applicant was in possession of the claimed method.

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Examiner notes that in order to accomplish the claimed limitation (i.e. vary the location of the billing information “so that the billing information is not always in the same area of the customized communication “) the present invention must store data with respect to the positioning of all information in each customer’s bill. In other words, in order to ensure that the invention varies the location of the information “relative to the billing information in the at least prior customized communication . . . so that the billing information is not always in the same area of the customized communication,” the invention must store information on where information was placed in “at least prior customized communication.”

There is simply nothing in the Specification that indicates that the disclosed system stores or saves a layout as presented to the user. As such there is no way for the system to be sure that a current bill varies from a prior bill. It is the Examiner position that Applicant was simply not in possession of such a system at the time of the present invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 7-8, 10-11, 18-19, 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munsil et al. in view of “How to remove your name from junk mail, phone-solicitation lists” by Denise Nelsen (hereinafter Nelsen)

Munsil et al. teaches a billing method comprising obtaining billing information for a customer from a database comprising customer profiles, customer billing information and non-billing information profiles and obtaining non-billing information pertinent to the customer ((column 3; lines 18-21) & (column 3; line 55- column 4; line 31 and Figure 1)).

Examiner notes that the bill production processor system 15 extracts (obtains) from a customer database or databases 14, the customer data to be printed on the billing statements (column 4; lines 22-24). The customer data extracted includes account status information, customer address information, account balance information, legal notices, promotional notices and other data for each of the customers to be billed (column 4; lines 28-31). Examiner notes that account status information, customer address information and account balance information represent billing information. Additionally, legal notices and promotional notices represent non-billing information.

Munsil et al. teaches combining the billing information and non-billing information to create a customized communication (e.g. column 11; lines 34-56 and column 12; lines 1-24).

Examiner notes that Munsil et al. teaches messages that are included on a billing statement and these messages represent non-billing information pertinent to a customer. Further a billing statement with a message represents Applicant's customized communication.

Munsil et al. teaches conveying said customized communication to the customer (column 1; lines 25-33). Examiner notes that Munsil et al. teaches that sending billing statements is old and well known, thus Munsil et al. anticipates that the customized billing statements generated

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by the method and system of Munsil et al. will be received by the customer (conveyed to the customer).

Munsil et al. teaches a report editor which allows a report designer to use a palette of tools to customize where data is to appear on a report or bill. The report designer will decide how the report/bill will generally appear, and using tools, create a graphical layout of where textual information will physically appear on the report/bill (column 2; lines 20-27). Examiner notes that this includes the customized placement of both billing information (column 5; lines 30-52) and non-billing information (column 12; lines 55-60).

However, while Munsil et al. teaches that a report editor can customize the layout of report any way he/she chooses, Munsil et al. does not specifically teach positioning the non-billing information between a customer identifier located at the beginning of the communication and a billing amount located at the end of the communication.

Examiner notes, based on Applicant's specification the specific positioning of the non-billing information (i.e. between a customer identifier at the beginning and a billing amount at the end of the communication) is not a critical feature of the present invention. In fact Applicant's only mention of the placement of the non-billing information is found on page 2; lines 17-20: "in one embodiment, the billing information is not always located in the same area of the newsletter. This may induce a customer to read non-billing information while searching for the billing information, particularly since the information is tailored to the customer." Examiner notes that this indicates that dynamic placement of the non-billing information may induce a customer to read the information. This statement makes clear that the specific

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placement of non-billing information holds no functional importance (as it's as likely that the dynamic placement may not induces a customer to read the non-billing information) nor does it produce an unexpected or distinct result. Moreover, it appears that placing the ad anywhere within the bill will perform equally well, as placement may or may not induce a customer to read the information.

As Applicant fails to demonstrate the criticality of the specific limitation, (i.e. placement of non-billing information between a customer identifier at the beginning and a billing amount at the end of the communication) Examiner finds the limitation to be an aesthetic design choice (see MPEP 2144 and 2144.04 I). Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Munsil et al. to include the specific placement of message data (non-billing information) between a customer identifier at the beginning of the report/bill (communication) and the billing amount at the end.

Examiner finds support for the motivation to modify Munsil et al. in a court based ruling stating that matter relating to ornamentation only cannot be relied upon to patentably distinguish the claimed invention from the prior art (In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)). Further Examiner notes that legal precedent can provide the rationale supporting obviousness (MPEP 2144).

Munsil further does not teach wherein the customer can opt not to receive any non-billing information.

Nelsen teaches that it is old and well known in the art for consumers to not want to receive direct marketing solicitations. Nelsen further teaches the ability to not receive these

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solicitations by requesting not to receive them and being placed on a list. One of ordinary skill in the art at the time of the present invention would recognize that such a list is valuable in order to satisfy the references of those customers who wish be to exposed to as few advertisements as possible in their daily lives.

It would have been obvious to one of ordinary skill in the art to modify the teachings Munsil to include a list of consumers who wish to not receive non-billing information as taught by Nelsen. One of ordinary skill in the art would have been motivated to make such a modification in order to satisfy the preferences of those customers who wish be to exposed to as few advertisements as possible in their daily lives.

Examiner notes that the analysis provided above for the rejection of method claim 1 above, also applies to system claim 10. In addition, Examiner notes that the database(s) of Munsil et al. are relational (column 5; lines 44-45).

Munsil et al. teaches creating a set of classifications that correlate to customer traits, assigning applicable classification from that set of classifications to customers and recording the applicable classifications in respective customer profiles (claim 4). Examiner notes that Applicant discloses by way of an example (page 4; lines 13-15 of the Specification) that classifications may include characteristics about a customer, such as zip code in which the customer lives. Using this as an example, Examiner asserts that Munsil et al. teaches creating, assigning and recording a customer's zip code in a customer profile database (column 5; lines 44-52 and column 12; lines 44-46).



Munsil et al. teaches assigning applicable classifications to selected non-billing information, recording classifications in respective non-billing information profiles database (claim 4)(column 12; lines 2-24 and 40-42). Examiner notes that billing criteria represents applicable classifications. Further the act of billing personnel using a graphical user interface to define the billing criteria for a particular message represents assigning applicable classifications to selected non-billing information. Examiner asserts that once billing criteria (applicable classifications) are defined by the billing personnel they are saved. Examiner notes in order for the bill run to qualify each message against stored information for each customer, the billing criteria must also be stored.

Munsil et al. teaches wherein said customized communication comprises a newsletter (claims 7 and 18) (column 11; lines 45-55). Examiner notes that a newsletter is defined as a printed report giving news or information of interest to a special group (Webster's II New Riverside Dictionary). Therefore, providing on a bill for HBO subscribers (a special group) with a message with the promotion "Free Cinemax in the month of December for all HBO subscribers. Happy Holidays!" (news or information) represents a providing newsletter.

Munsil et al. teaches providing printed material to said customer via a delivery system (claim 8) and a printer in communication with computer system wherein said printer is capable of printing newsletter (claim 19) (column 1; lines 26-27; column 4; lines 50-51 and Figure 1).

Examiner once again notes that Munsil et al.'s teaching that customer's receiving billing statements anticipates that the customized billing statements of Munsil et al. are received by the customer.

Munsil et al. teaches a server connected to a network for communicating with a terminal connected to the network (claim 11) (column 4; lines 1-5 and Figure 1). Examiner notes that the customer management system comprises a user terminal for a user to interact with the report editor and report generator feature.

Munsil et al. teaches a set of classifications correlated to customer traits (claim 12) (column 12; lines 15-24). Examiner notes that billing criteria represents classifications. Further it is recognized that these billing criteria (classifications) are correlated to customer traits, for example indicating if a customer subscribes to HBO or lives in a particular tax area.

Munsil et al. teaches wherein applicable classifications are assigned to customers and non-billing information (claim 13) (column 12; lines 15-24). Examiner once again asserts that billing criteria represents classifications. And notes that the billing criteria is assigned to the messages (non-billing information) and are matched with identical criteria (classifications) already assigned to each customer in the customer table (e.g. HBO subscriber, tax area).

Munsil et al. further teaches wherein instructions for assigning applicable classifications to customers and non-billing information (claim 15) (column 12; lines 15-24). Examiner notes

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that the standard logic used represents the instruction for classifying the customer and the message (non-billing information).

Munsil et al. teaches wherein obtaining non-billing information pertaining to the customer comprises selecting non-billing information related to the customer from a non-billing information profile according to a set of classifications stored in the non-billing information profile that is identical to a set of classifications stored in a customer profile corresponding to the customer (claim 21) (column 12; lines 1-24 and 40-42).

Examiner notes that billing criteria of Munsil et al. represents Applicant's classifications of non-billing information. As such, the messages (non-billing information) are qualified (selected) based on a set of classifications (billing criteria) that are identical to a set of classification stored in a customer profile. Examiner notes the example on column 12; lines 17-20 where the billing criteria (classification stored in non-billing information profile) is franchise tax area 8010. When this billing criteria matches the identical classification found in the customer table the message is deemed pertinent to that customer.

Munsil et al. teaches a customer table, wherein said customer table comprises customer information, unique customer identifiers and classifications assigned to customers (claim 22) (column 5; lines 44-52). Examiner once again points to Applicant's Specification page 4; lines 13-15 that states, "classifications may include characteristics about the customer, such as zip code in which the customer lives." Examiner notes that since customer database of Munsil et al.

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contains zip code information, then the database contains classifications assigned to the customers.

Munsil et al. makes obvious a billing information table, wherein said billing information table comprises unique customer identifiers and customer billing information and has a relationship to said customer table based on said unique customer identifiers (claim 22)(column 5; lines 44-52).

Examiner notes column 5; lines 44-52 teaches as well known in the art relational databases organized in a plurality of tables with relations between the tables. Further the section seems to indicate maintaining billing information in one customer table rather than containing a separate billing table with a relationship between the two tables. As such Munsil et al. fails to teach a specific billing information database. However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the relational database structure to include a separate billing table with billing information and a relationship to the customer table in order to save disk space.

Munsil et al. teaches a non-billing information table, wherein said non-billing information table comprises non-billing information and classifications assigned to said non-billing information and has a relationship to said customer table based on classifications (column 12; lines 2-24 and 40-42). Examiner notes that billing criteria represents classifications assigned to non-billing information. Further, once billing criteria (assigned classifications) are defined by the billing personnel they are saved. Examiner notes in order for the bill run to qualify each message against stored information for each customer, the billing criteria must be stored in the computer. Examiner notes that the storage of the billing criteria associated with messages

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represents a non-billing information table with non-billing information (messages) and classifications (billing criteria) assigned to the non-billing information (messages). Additionally, the step of qualifying messages (non-billing information) against stored customer information, represents a relationship between the messages (non-billing information) and the stored customer data (customer table).

Munsil et al. teaches a report that combines billing information for a customer with non-billing information that possess an assigned classification matching an assigned classification of said customer, to create customized communication for customer (e.g. column 2; lines 4-8).

Munsil et al. teaches wherein non-billing information pertinent to the customer comprises news information pertinent to the geographic region in which the customer resides (claims 23 and 24) (column 12; lines 44-49). Examiner notes the information about imminent repairs represents news. Additionally, qualifying a message based on a users zip code relates to information pertinent to a geographical region in which a customer resides.

Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munsil et al. in view of Kovac as applied to the claims above, and further in view of Daniels Jr. et al.

Munsil et al. teaches that a user can specify that instead of printing the information in a report it can be drawn in a window on a computer screen, or written to a file on a disc, which can be accessed at a later time without having to go back to the database (column 2; lines 55-61).

Munsil et al. does not teach conveying customized communication to customer electronically (claims 9 and 20).

Daniels Jr. et al. teaches adding the capabilities of electronic mail delivery to existing mass mailing systems (column 1; lines 60-62). In particular the system separates documents into a physical delivery printstream and an electronic delivery printstream based on delivery preferences of the user (column 1; line 65 – column 2; line 2). Examiner notes that the printstream data sent is associated with a company's existing architecture (column 3; lines 37-41). Examiner notes that this is done in order to reduce the amount of paper associated with mass mailings.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the printing information stored on a disk of Munsil et al. by sending it to the printstream separator for electronic delivery as taught by Daniels Jr. et al. One of ordinary skill would have been motivated to modify the references in order to reduce the amount of paper used with the mass mailing system of Munsil et al.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 7-11 and 18-27 have been considered but are moot in view of the new ground(s) of rejection.

Specifically, Applicant's arguments with respect to Kovac and the limitation of "giving a user the option not to receive non-billing information."

Applicant also includes arguments directed towards the criticality of the position of the non-billing information. These arguments begin on line 6 of page 10 and continues through page 12.

Applicant's begin these arguments by the definition of the word "may". This is done to address Examiner's assertion regarding Applicant's disclose that changing the location of billing information "may induce a customer to read non-billing information." The Examiner argues that "may" amounted to an admission that such dynamic positioning of the non-billing information is not a critical feature and holds no functional importance. It is the Applicant's position that "the mere possibility that the claimed dynamic placement may not always induce customers, or every customer, to read the non-billing information does not detract from the functional intent and purpose of the dynamic placement."

Examiner respectfully disagrees with the Applicant.

First, Applicant suggests that the "context in which the applicant uses 'may' must be determined." Examiner would like to point out that the context of this embodiment is found in the Summary of Invention section and nowhere else in the entire Specification. Applicant fails to even mention this feature in the Detailed Disclosure section. This is a clear indication that the feature is not considered, by Applicant to be critical to the invention.

Second, upon review of paragraph 7, Examiner notes that Applicant states that "to increase the likelihood that information will be successfully viewed to a customer by including the bill with the non-billing information." This sentence has nothing to do with the placement of the billing or non-billing information. Rather, the "increased likelihood" is a result of "including the bill with the non-billing information." Applicant introduces the placement by stating, "in addition, in one embodiment, ..." Examiner asserts that there is no nexus, in the Specification between the increased likelihood that information will be successfully conveyed and the placement of the information.

Third, Applicant "function intent" holds no bearing on the functional significance of the claimed feature. Applicant's "intentions" do not establish a functional significance.

Lastly, Applicant's intended inventive concept, as evidenced by the Detailed Disclosure section relates the concept of relating non-billing information to a customer profile and not to the specific placement of the information on the sheet. In addition the system and method of Munsil clearly teaches the ability to place billing and non-billing information in any format and in any placement. The specific placement is simply not a patentably distinct feature.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (571) 272 6783.

The examiner can normally be reached on Monday - Friday (8AM - 5PM).



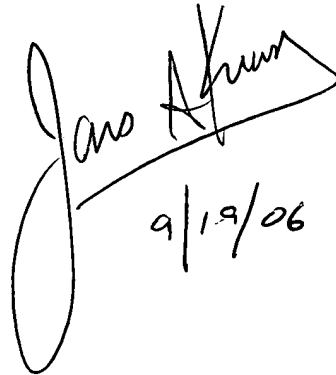
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272 6771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer  
Examiner  
Art Unit 3627

jak

A handwritten signature, likely of James A. Kramer, is written in black ink. Below the signature, the date "9/19/06" is handwritten.